

Remarks/Arguments

Claims 1-9 are pending in this application, and are rejected in the final Office Action of November 17, 2005. Claims 1 and 9 are amended herein. These amendments are deemed to place this application in even better condition for allowance and reconsideration is respectfully requested.

Re: Claims 1 and 9

Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/10589 (hereinafter, "Blake") in view of USPN 6,772,433 (hereinafter, "LaJoie"). Applicants traverse this rejection for at least the following reasons.

Independent claim 1, as amended herein, defines a method for operating a video processing apparatus, comprising the steps of:

“receiving by said video processing apparatus an electronic mail message remotely from a user, said electronic mail message comprising a plurality of fields including a subject field having an operating command and another field having control information relating to time and channel data of a selected event;

processing said electronic mail message in said video processing apparatus to determine said time and channel of the selected event;

forwarding by said video processing apparatus another electronic mail message to the user if there is a conflict between said time and channel data and a preexisting timer event; and

operating said video processing apparatus in response to said operating command and said control information if there is no conflict between said time and channel data and any preexisting timer event.”

As indicated above, amended independent claim 1 defines a method for operating a video processing apparatus by receiving an electronic mail message remotely from a user. The electronic mail message comprises a plurality of fields

including a subject field having an operating command and another field having control information relating to time and channel data of a selected event. The video processing apparatus also forwards another electronic mail message to the user if there is a conflict between the time and channel data and a preexisting timer event. The video processing apparatus operates in response to the operating command and control information if there is no conflict between the time and channel data and any preexisting timer event.

Neither Blake nor LaJoie, whether taken individually or in combination, teach or suggest the method of independent claim 1. While Blake includes a single sentence at the end of his disclosure stating that a “user may also send recording requests via e-mail to an account connected to processing system 334” (see page 18, lines 27-29), he provides absolutely no information regarding how such a system may be made or used. As such, Blake clearly fails to provide an enabling disclosure that teaches how an electronic mail message may be used to operate a video processing system, as claimed. Applicants note that in order for a reference to be considered prior art under 35 U.S.C. §102, “the reference must put the anticipating subject matter at issue into the possession of the public **through an enabling disclosure.**” Emphasis added – *Chester v. Miller*, 906 F.2d 1574, 15 USPQ2d 1333 (Fed. Cir. 1990). In this case, Blake's single sentence disclosure cited above can hardly be considered an enabling disclosure under the Patent Law.

LaJoie fails to even suggest that e-mail can be used as a means to operate a video processing apparatus, as claimed, and thereby fails to remedy the deficiencies of

Blake. Accordingly, neither Blake nor LaJoie, whether taken individually or in combination, disclose or suggest an enabling embodiment including, *inter alia*, an "electronic mail message comprising a plurality of fields including a subject field having an operating command and another field having control information relating to time and channel data of a selected event" as recited by independent claim 1. For these reasons alone, the instant rejection of claims 1 and 9 should be withdrawn.

Re: Claims 2-8

Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blake in view of US 2004/0103439 (hereinafter, "Macrae"). Applicants respectfully traverse this rejection for at least the following reasons.

Independent claim 2 defines a method for operating a video processing apparatus comprising the steps of:

"receiving a message directly from a user in email format including sender, subject and control information, wherein the subject comprises an operating command for operating said video processing apparatus;
processing, in said video processing apparatus, said message to determine said control information; and
operating said video processing apparatus in response to said operating command and said control information."

As indicated above, independent claim 2 defines a method for operating a video processing apparatus by using a message having an email format. The message includes control information and a subject comprising an operating command for the video processing apparatus. The video processing apparatus is operated in response to the operating command and control information.

Neither Blake nor Macrae, whether taken individually or in combination, teach or suggest the method of independent claim 2. As previously explained herein with reference to independent claim 1, Blake fails to provide an enabling disclosure that teaches how an e-mail format message may be used to operate a video processing system, as claimed. Macrae discloses a television system having e-mail capability, but fails to remedy the scant one sentence disclosure of Blake relied upon by the Examiner. Accordingly, neither Blake nor Macrae, whether taken individually or in combination, disclose or suggest an enabling embodiment including, *inter alia*, "a message . . . in email format including sender, subject and control information, wherein the subject comprises an operating command for operating said video processing apparatus" as recited by independent claim 2.

On page 7 of the final Office Action, the Examiner states:

"Blake fails to show that the email message contains subject and sender information. Macrae shows that email messages normally contain subject and sender information (page 6 section 0055, viewer may view the subject or sender of the message). Furthermore, as discussed above, Blake fails to explicitly disclose that the subject comprises an operating command for operating said video processing apparatus. While it is not directly disclosed, the subject line of the e-mail message is arbitrary and can contain anything that the user desires, therefore, placing the operating command in the subject versus placing it in the body is totally up to the discretion of the user and since Blake is silent as to the configuration of the e-mail message, common knowledge suggests that the operating command **could be** placed in the subject line, as would be obvious to one of ordinary skill in the art." (emphasis added)

The above-referenced rationale for the instant §103 rejection is fundamentally flawed by the use of impermissible hindsight reconstruction. The essence of the

Examiner's argument is that since an operating command could be included in the subject line of an e-mail for purposes of operating a video processing apparatus, it would have been obvious to one of ordinary skill in the art to do so. This type of rejection is clearly impermissible under Federal Circuit law. It is well established that rejections under §103 be based on some teaching or suggestion included in the prior art itself. In other words, the mere fact that a prior device could be modified in a certain manner does not render that modification obvious for purposes of §103 unless the prior art suggests the desirability of the modification. See, for example, *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989). In this case, the prior art provides absolutely no teaching or suggestion regarding the desirability of including an operating command in the subject line of an e-mail for purposes of operating a video processing apparatus, as claimed. For this reason alone, the instant rejection of claims 2-8 should be withdrawn.

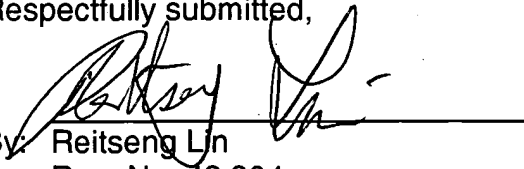
Conclusion

Having fully addressed the Examiner's rejections it is believed that, in view of the foregoing amendments and remarks/arguments, this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled.

Fee

No fee is believed due. However, if a fee is due, please charge the fee to
Deposit Account 07-0832.

Respectfully submitted,


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CERTIFICATE OF MAILING

I hereby certify that this amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on:

2-15-06
Date

Karen Schleich